

REMARKS

In the Office Action mailed April 24, 2006, the following issues were raised:

1. Claims 1-9 and 11-16 were rejected under 35 U.S.C. § 112, first paragraph, for failing to meet the written description requirement;
2. Claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
3. Claims 7 & 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,732,237 to Jacobs et al.; and
4. Claims 1-6, 8, and 11-16 were rejected under 35 U.S.C. § 103(a) as being obvious over the Jacobs et al. reference in view of the Official Notice taken by the Examiner.

Interview Summary

On July 13, 2006, the undersigned conducted a telephone interview with Examiner Refai. The subject of the interview was the rejection of the claims under 35 U.S.C. § 112 with respect to the limitation "localized to the computer". The undersigned presented the remarks below in support of withdrawing the rejection. No conclusion was reached with regards to the rejection or its withdrawal.

Rejections Under 35 U.S.C. § 112

The rejection of claims 1-9 under 35 U.S.C. § 112, first paragraph, are unfounded. The rejection asserts that the exclusive communication between the computer and the processor, between the processor and the remote file server, and between the computer and the storage device is not fully supported in the specification. This assertion, however, is not accurate.

Paragraph 25 of the specification supports the limitation of “the computer interface is adapted to enable communications exclusively between the computer and the processor” found in claim 1 and the limitation of “the computer interface is adapted to enable communications exclusively between the computer and the storage device” found in claim 4. Particularly, the specification indicates that one of many commonly known interface formats can be used for the computer interface, namely IDE, ATA, SCSI, and IEEE 1394. Each of these interface formats are known to connect and allow communications exclusively between a single computer and a single storage device. Thus, the specification inherently discloses the “exclusive communication” limitations between the computer and the processor and storage device of claims 1 and 4, respectively.

Paragraph 30 of the specification supports the limitation of “the network interface for communications exclusively with the remote file server” found in claim 1. Specifically, paragraph 30 recites:

“In other words, the CBD file server 314 will not communicate with any device other than the CBD 202 and the CBD 202 will not communicate with any server other than the CBD file server 314.”

As is evident from this excerpt, the specification expressly discloses the claim limitation in question.

Claims 1, 4, and 7 were also rejected under 35 U.S.C. § 112, first paragraph, based on the phrase “localized to a computer”. This phrase is both expressly and inherently supported by the written description of the specification. First, Fig. 3 illustrates the storage device 202 enclosed within the computer 301. Fig. 3 therefore shows an example of how the storage device 202 can be “localized to a computer”. Further, Fig. 2 shows that the storage device 202 containing the processor 206. The combination of Figs. 2 & 3 therefore discloses an example of how the processor 206

can be “localized to a computer”. Thus, the specification of the present application expressly describes the term “localized to a computer”.

Moreover, the meaning of the term “localized” is implied in the specification through the plain and ordinary meaning of the word. The undersigned’s desk reference dictionary lists the meaning of “localized” as “confined or restricted to a particular place”. From this definition, it is easily inferred that the term “localized to a computer” means “confined or restricted within the vicinity of a computer”. For each of the above-stated reasons, each of claims 1-9 meet the written description requirement of 35 U.S.C. § 112, first paragraph.

Claims 1-9 were also rejected as indefinite under 35 U.S.C. § 112, second paragraph, for the phrase “localized to a computer”. For the same reasons stated above, this phrase is sufficiently definite to meet the statutory requirement.

Anticipation Rejections

Claim 7 was rejected as anticipated by the Jacobs et al. reference. A finding of anticipation requires that each and every element of the claimed invention be described, either expressly or inherently, in a single prior art reference. Claim 7 includes the limitations of “the storage device is localized to the computer” and “computer interface being adapted to enable communications exclusively between the computer and the storage device”. The Jacobs et al. reference does not disclose these limitations.

The Jacobs et al. reference discloses a cache server 102 which is connected to and accessible by a plurality of user workstations 108a, 108b, 108c via a network 104, such as the Internet. The cache server 102 caches data files provided or generated by the server 106 and supplies those data files when a request is made from one of the user workstations 108a, 108b, 108c for one or more of the data files. In other words, any one of the user workstations 108a, 108b, 108c may request data files from the single cache server 102. In addition, the Jacobs et al. reference indicates that cache

server 102 may be “co-located” with the server 106, i.e. separate pieces of hardware residing in the same physical location. In contrast, the Jacobs et al. reference *does not* disclose that the cache server 102 is localized, or “co-located”, with any of the user workstations 108a, 108b, 108c.

Moreover, as indicated above each of the user workstations 108a, 108b, 108c are connected to each other via the network 104, with no further details being provided by the Jacobs et al. reference regarding the network interface necessarily included with of each of these user workstations 108a, 108b, 108c. Therefore, the implication is that the network interface of the user workstations 108a, 108b, 108c have the same functionality that the person skilled in the art would expect to find in a standard network interface. This standard functionality includes the ability to communicate with all other devices on a network so long as the other devices are configured to accept such communications. Since the Jacobs et al. reference includes no detail about the how the network interfaces of the user workstations 108a, 108b, 108c are configured, a broad interpretation of the Jacobs et al. reference implies that each of the user workstations 108a, 108b, 108c can communicate via the network 104 with each of the other user workstations 108a, 108b, 108c, in addition to being able to communicate with the cache server 102. Therefore, the network interface of each user workstation 108a, 108b, 108c is not configured to enable communications “exclusively between” the respective user workstation and the cache server 102. Thus, because the Jacobs et al. reference does not teach every limitation of claim 7, it does not anticipate claim 7.

Claim 9 depends from claim 7 and was also rejected as anticipated by the Jacobs et al. reference. Where the Jacobs et al. reference does not anticipate claim 7, it also does not anticipate claim 9.

Obviousness Rejections

The remaining rejections in the Office Action are based upon obviousness. The MPEP has set the following standard for establishing a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2142. For the reasons discussed below, the combination of the Jacobs et al. reference and the matter of Official Notice fails to teach or suggest all of the limitations in the rejected claims. The cited combination is therefore insufficient to establish a *prima facie* case of obviousness over the rejected claims.

Claim 1 was rejected as obvious over the Jacobs et al. reference in view of the Official Notice taken by the Examiner. This Official Notice relates the storage device returning a “file unavailable notice” to the computer when a requested file is not cached and is not available from the file server. Claim 1 includes the limitations of “a processor localized to a computer”, “the computer interface is adapted to enable communications exclusively between the computer and the processor”, and “the processor is adapted to employ the network interface for communications exclusively with the remote file server”. None of these limitations are taught or suggested by the Jacobs et al. reference and are not the subject of the Official Notice.

As discussed above in relation to the anticipation rejection of claim 7, the Jacobs et al. reference does not teach or suggest the limitations of “a processor localized to a computer” and “the computer interface is adapted to enable communications exclusively between the computer and the processor”. The Jacobs et al. reference also does not

teach or suggest the limitation of “the processor is adapted to employ the network interface for communications exclusively with the remote file server”. The cache server 102 disclosed in the Jacobs et al. reference clearly includes a network interface to enable the system shown in Fig. 1 and the functionality described in connection therewith. Because the cache server 102 communicates with the various user workstations 108a, 108b, 108c via the network 104, the network interface included with the cache server evidently enables the cache server to communicate with each of the user workstations 108a, 108b, 108c. Further, the Jacobs et al. reference is silent as to the type of connection employed between the cache server 102 and the server 106. Thus, even if the cache server 102 employs its network interface to communicate with the server 106, the Jacobs et al. reference also teaches that the same network interface is employed by the cache server 102 for communications with the various user workstations 108a, 108b, 108c. For these reasons, the cited combination does not establish a *prima facie* case of obviousness over claim 1.

Claims 2 & 3 each ultimately depend from claim 1. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over claim 1, the cited combination also does not establish a *prima facie* case of obviousness over claims 2 & 3.

Claim 4 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claim 4 includes the limitations of “the storage device being localized to the computer”, “the computer interface is adapted to enable communications exclusively between the computer and the storage device”, and “the processor is adapted to employ the network interface for communications exclusively with the remote file server”. For the same reasons discussed above with reference to claim 1, the cited combination does not establish a *prima facie* case of obviousness over claim 4.

Claims 5 & 6 each ultimately depend from claim 4. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over claim 4, the cited combination also does not establish a *prima facie* case of obviousness over claims 5 & 6.

Claims 8 & 16 were also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claims 8 & 16 depend from claim 7, and as discussed above, the Jacobs et al. reference does not disclose all of the limitations of claim 7. Moreover, the matter of Official Notice fails to fill in the gaps in the teachings of the Jacobs et al. reference. Therefore, the cited combination does not establish a *prima facie* case of obviousness over claims 8 & 16.

Claim 11 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claim 11 includes the limitations of “the processor is adapted to employ the network interface for communications exclusively with the remote file server” and “upon the computer being booted, the computer sends a request for a file to the processor, the file being a bootstrap file or operating system file”. As discussed above with reference to claim 1, neither Jacobs et al. reference nor the matter of Official Notice teach or suggest these limitations. Moreover, if such the limitation of exclusive communications were imposed upon the cache server 102 of the Jacobs et al. reference, the functionality of the overall system disclosed therein would be eviscerated. The Jacobs et al. reference also does not teach or suggest the user workstations 108a, 108b, 108c requesting a bootstrap or other operating system file from the cache server 102 upon being booted nor the ability of the cache server 102 to provide such files for purposes of booting the user workstations 108a, 108b, 108c. Rather, the user workstations 108a, 108b, 108c of the Jacobs et al. reference appear to function as common desktop computers. In other words, the user workstations 108a, 108b, 108c require a functioning operating system *before* they can communicate with the cache server 102, i.e., the user workstations have been booted using a local

bootstrap file, which is the first file used by common desktop computers during the boot process. Thus, the user workstations 108a, 108b, 108c disclosed in the Jacobs et al. reference cannot obtain a bootstrap file from the cache server 102. Once again, the matter of Official Notice does not fill in the gaps in the teachings of the Jacobs et al. reference. Therefore, the cited combination does not establish a *prima facie* case of obviousness over claim 11.

Claims 12 & 13 each ultimately depend from claim 11. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over claim 11, the cited combination also does not establish a *prima facie* case of obviousness over claims 12 & 13.

Claim 14 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claim 14 includes the limitations of “the processor is adapted to employ the network interface for communications exclusively with the remote file server” and “upon the computer being booted, the computer sends a request for a file to the processor, the file being a bootstrap file or operating system file”. As discussed above with reference to claim 11, neither the Jacobs et al. reference nor the matter of Official Notice teach these limitations. Therefore, the cited combination does not establish a *prima facie* case of obviousness over claim 14.

Claim 15 depends from claim 14. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over claim 14, the cited combination also does not establish a *prima facie* case of obviousness over claim 15.

For each of the above reasons, reconsideration of the rejections is requested.

Respectfully submitted,

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DATE: July 14, 2006

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